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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/360,068	07/23/1999	KEVIN J. PAGE	2322-0482	3638

27111 7590 06/20/2003

BROWN, MARTIN, HALLER & MCCLAIN LLP
1660 UNION STREET
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EXAMINER-

KLIMACH, PAULA W

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/360,068

Applicant(s)

PAGE ET AL.

Examiner

Paula W Klimach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 9.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 10.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

A telephone call was made to Kathleen L. Connell on Wednesday May 22, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 36-40, drawn to use of a transaction form such as Web Page, see Fig. 5-7, and page 17 line 27 to page 20 line 7, classified in class 705, subclass 1-64.
- II. Claims 1-24, drawn to a system for establishing secure link between a smart card and a central computer, classified in class 713, subclass 201, page 6 line 17 to page 15 line 17.
- III. Claims 41-48 and 54-58, drawn a system for establishing a secure link using authentication, see page 9 line 33 to page 11 line 15, classified in class 713, subclass 202.
- IV. Claims 49-53, drawn to temporary software application, see Page 15 line 16 to page 17 line 26, classified in class 709, subclass 200.

The inventions are distinct, each from the other because of the following reasons:

Inventions I. and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as electronic form for use in any transaction performed electronically, these transactions do not have to be between the smart card and the central computer. Invention II has separate utility for establishing a secure communication link between a smart card and computer no electronic form is necessary. See MPEP § 806.05(d).

Inventions I. and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as electronic form for use in any transaction performed electronically, these transactions do not have to establish a secure communication link by using authentication. Invention III has a separate utility for establishing a secure link using authentication, secure link that uses authentication does not require a transaction form. See MPEP § 806.05(d).

Inventions I. and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as electronic forms for use in any transaction performed electronically, these transactions do not have to use temporary software. Invention IV has a separate utility for temporary software applications, temporary software applications do not have to use electronic transaction forms. See MPEP § 806.05(d).

Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as transferring data securely between a smart card and a central computer in any transaction not limited to transactions using a web page. Invention I has separate utility such as electronic forms for use in any transaction performed electronically, transactions do not have to be between a smart card and a central computer. See MPEP § 806.05(d).

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as transferring data securely in any transaction between a smart card and a central computer not limited to security by authentication. Invention III is a separate utility such as a secure link using authentication that does not have to be a secure link between a smart card and a central computer. See MPEP § 806.05(d).

Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as transferring data securely in any transaction between a smart card and a central computer not limited to the use of temporary software applications such as Java applications. Invention IV is a separate utility of

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temporary software applications such as Java applications, these applications do not have to be between a central computer and a smart card. See MPEP § 806.05(d).

Inventions III and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as authenticating not limited to transactions using transaction forms such as Web pages. Invention I has separate utility such as electronic forms for use in any transaction performed electronically, electronic forms do not have to establish secure links using authentication See MPEP § 806.05(d).

Inventions III and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as authenticating data not limited to establishing secure links between a smart card and a central computer. Invention II has a separate utility of establishing secure links between a smart card and a central computer the secure link does not have to be established using authentication. See MPEP § 806.05(d).

Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as authenticating data not limited to temporary software applications such as Java applications. Invention IV has a

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separate utility of temporary software applications such as Java applications, these applications do not have to be for establishing secure communication links using authentication. See MPEP § 806.05(d).

Inventions IV and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as downloading remote executables not limited to transaction forms such as Web pages. Invention I has a separate utility of electronic forms for use in any transaction performed electronically, the electronic transaction forms do not have to be temporary software applications. See MPEP § 806.05(d).

Inventions IV and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as downloading remote executables not limited to establishing secure links between a smart card and a central computer. Invention II has a separate utility of establishing a link between a smart card and a central computer, the secure link does not require a temporary software application. See MPEP § 806.05(d).

Inventions IV and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be

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separately usable. In the instant case, invention IV has separate utility such as downloading remote executables not limited to establishing secure links between a smart card and a central computer. Invention III has a separate utility of establishing a secure link using authentication, the secure link does not require a temporary software application. See MPEP § 806.05(d).


Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W Klimach whose telephone number is (703) 305-8421. The examiner can normally be reached on Mon to Fri 7:15 a.m to 3:45 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes can be reached on (703) 305-9711. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-8421 for regular communications and (703) 305-8421 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4832.

PWJ


GAIL HAYES
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